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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,023	09/09/1999	PAUL S. MEISSNER	PF-200	2146

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HUMAN GENOME SCIENCES INC
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EXAMINER

KAUFMAN, CLAIRE M

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 06/19/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/393,023

Applicant(s)

MEISSNER ET AL.

Examiner

Claire M. Kaufman

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 16 and 19-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14, 16, and 19-95 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 21-95 are directed to the following inventions:

1. Isolated proteins comprising amino acid residues 1-223 of SEQ ID NO:2
2. Isolated proteins comprising amino acid residues 1-173 of SEQ ID NO:2 except for those proteins comprising amino acid residues 1-223 of SEQ ID NO:2.
3. Isolated proteins comprising amino acid residues 24-223 of SEQ ID NO:2 except for those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
4. Isolated proteins comprising amino acid residues 24-67 of SEQ ID NO:2 except for those proteins comprising amino acid residues 24-173 of SEQ ID NO:2, those proteins comprising amino acid residues 1-173 of SEQ ID NO:2, those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
5. Isolated proteins comprising amino acid residues 24-173 of SEQ ID NO:2 except for those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, those proteins comprising amino acid residues 1-173 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
6. Isolated proteins comprising amino acid residues 45-128 of SEQ ID NO:2 except for those proteins comprising amino acid residues 24-173 of SEQ ID NO:2, those proteins comprising amino acid residues 1-173 of SEQ ID NO:2, those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
7. Isolated proteins comprising amino acid residues 68-173 of SEQ ID NO:2 except for those proteins comprising amino acid residues 24-173 of SEQ ID NO:2, those proteins comprising amino acid residues 1-173 of SEQ ID NO:2, those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
8. Isolated proteins comprising amino acid residues 68-223 of SEQ ID NO:2 except for those proteins comprising amino acid residues 24-223 of SEQ ID NO:2 and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
9. Isolated proteins comprising amino acid residues 129-207 of SEQ ID NO:2 except for those proteins comprising amino acid residues 68-223 of SEQ ID NO:2, those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2

10. Isolated proteins comprising amino acid residues 174-223 of SEQ ID NO:2 except for those proteins comprising amino acid residues 68-223 of SEQ ID NO:2, those proteins comprising amino acid residues 24-223 of SEQ ID NO:2, and those proteins comprising amino acid residues 1-223 of SEQ ID NO:2
11. Isolated proteins comprising a polypeptide fragment of amino acids 1-223 of SEQ ID NO:2 wherein the polypeptide fragment stimulates cell growth and is not any of the fragments listed in claim 21(a)-21(j).
12. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 1-223 of SEQ ID NO:2
13. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 1-173 of SEQ ID NO:2
14. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 24-223 of SEQ ID NO:2
15. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 24-67 of SEQ ID NO:2
16. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 24-173 of SEQ ID NO:2
17. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 45-128 of SEQ ID NO:2
18. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 68-173 of SEQ ID NO:2
19. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 68-223 of SEQ ID NO:2
20. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 129-207 of SEQ ID NO:2
21. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to amino acid residues 173-223 of SEQ ID NO:2
22. Isolated proteins comprising an amino acid sequence 90% or more but not 100% identical to a polypeptide fragment of amino acids 1-223 of SEQ ID NO:2 wherein the polypeptide fragment stimulates cell growth and is not any of the fragments listed in claim 46(a)-46(j)
23. Isolated proteins comprising at least 30 contiguous amino acids of SEQ ID NO:2 but wherein the at least 30 contiguous amino acids are not any of the fragments listed in claim 21(a)-21(j)

The remaining claims are directed to the following inventions:

24. Claim 14, drawn to a compound that inhibits specific polypeptides, classified in class 530, subclass 388.24.
25. Claim 16, drawn to a process for identifying compounds that inhibit specific polypeptides, classified in class 435, subclass 7.21.
26. Claim 19, drawn to a process for diagnosing a disease by mutation analysis, classified in class 435, subclass 6.
27. Claim 20, drawn to a method of detecting polypeptide presence, classified in class 435, subclass 7.1, for example (classification is dependent on the method steps).

The inventions are independent or distinct from each other for the following reasons:

Each of Groups 1-23 is directed to isolated proteins wherein the proteins of each Group differ in structure relative to the proteins of each of the other Groups. Because of the difference in structure between the isolated proteins of each of the Groups, they are not related to each other (i.e., they are independent) and would be expected to have different properties and characteristics from each other.

Each of Groups 1-23 is independent from the compounds of Group 24. Specifically, each of Groups 1-23 is directed to isolated proteins whereas Group 24 is directed to inhibitor compounds that do not even have to be protein.

Each of Groups 1-23 is independent from each of the methods of Groups 25-27 since none of the methods make, use, or are otherwise related to the proteins in Groups 1-23.

The compounds of Group 24 are related to the method of Group 25 only insofar as the method of Group 25 can be used to identify the compounds of Group 24. However, these inventions are distinct from each other because the compounds of Group 24 could be identified using a method other than that of Group 25, such as a non-cellular method.

The compounds of Group 24 are independent from the methods of Groups 26-27 because there is no relationship whatsoever between these Groups, i.e., the methods of Groups 26-27 do not make, use, or identify the compounds of Group 24.

The methods of Groups 25-27 are independent from each other because they each require different method steps and obtain different results.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and

the search required for one group is not coextensive with any other, restriction for examination purposes as indicated is proper.

If applicants elect one of Groups 1-23, applicants are also required to list all the claims readable on the elected invention. Note, this is not an election of species requirement but a restriction between independent or distinct inventions. Note also that if applicants elect one of Groups 1-23, rejoinder of certain groups will be considered depending on the results of the search and examination and as long as there is no burden in examining the groups together in one application.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman whose telephone number is 703-308-5791. Dr. Kaufman can normally be reached on Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. Please advise the examiner at the telephone number above before facsimile transmission.

Claire M. Kaufman, Ph.D.



Patent Examiner, Art Unit 1646
June 10, 2002